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EXAMINER

KENEALY, D

F3M1

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ST. LOUIS, MO 63101

ART UNIT

PAPER NUMBER

3301

DATE MAILED:

04/29/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

- ☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-21 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-21 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).

12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Claim 12 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is improperly alternative since plastic and wire are two separate materials.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,4,6,8,9 and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Totaro US Patent 4,664,628. Totaro discloses a body protective device that comprises an impervious membrane, 6, mounted on a supporting device, 1. The device comprises a frame that holds the flexible membrane in place over the user's mouth and has a rigid handle portion, 8 and 9, extending from the frame. The operator can use the handle to manipulate the device.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in

the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 2,3,5,10,11 and 14,15,17-21 are rejected under 35 U.S.C. § 103 as being unpatentable over Rubin in view of Totaro. Rubin discloses a "kissing shield" type device which is used for the same purpose as applicant's device - to deter the communication of disease between two people. Rubin fails to disclose the structure for holding the apparatus to the user's face as claimed by applicant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the ear holding means of Rubin with a wire support that is hand held and easily manipulated because one could have looked to Totaro to see the benefits of using a pliable wire member to hold a mouth protective covering in place. The means by which the Rubin device is secured to the frame member is also considered to be an obvious design choice that one skilled in the art could have realized. The Totaro device already shows the need for two separate sheets of material to be fastened together so that the protective membrane can be held on its supporting frame. This fastening of the two separate sheets can be said to comprise a "flexible bag" in which the wire is inserted.

Claim 16 is rejected under 35 U.S.C. § 103 as being unpatentable over Rubin in view of Totaro as applied to claim 14 above, and further in view of Kware. Rubin in view of Totaro discloses everything in applicant's invention except for the flexible membrane consisting of a flexible bag. If one had wanted to remove the ear attachments from Rubin and place a second layer of latex behind the first so that a flexible bag is formed, one could have looked to Kware to find the motivation to do so. Using a bag type article secured to a framework instead of the more intricate seamwork that encapsules the wire itself is an obvious modification to the Rubin in view of Totaro device. Each structure can be considered an equivalent means for holding a flexible membrane in a flat planar position.

Claims 7 and 13 are rejected under 35 U.S.C. § 103 as being unpatentable over Totaro in view of Favary. Totaro discloses everything in applicant's claims except for the design and plurality of colors being present on the flexible membrane. Favary teaches the use of ornamental design on the surface of a face protector. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a design using different colors on the flexible membrane of Totaro for purpose of promotion, advertisement or aesthetics because such a design is shown in the Favary teaching.

Claim 11 is rejected under 35 U.S.C. § 103 as being unpatentable over in view of Forbes. It would have been obvious to

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one of ordinary skill in the art at the time the invention was made to have used polyethylene, vinyl or polypropylene to comprise the flexible membrane of Totaro because Forbes teaches the use of vinyl to comprise a flexible membrane for protecting a user's face.

Claim 19 is rejected under 35 U.S.C. § 103 as being unpatentable over Rubin in view of Totaro and further in view of Forbes. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used polyethylene, vinyl or polypropylene to comprise the flexible membrane of Rubin because Forbes teaches the use of vinyl to comprise a flexible membrane for protecting a user's face.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Kenealy whose telephone number is (703) 308-2680.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

DK
David Kenealy
April 18, 1993

Robert A. Kenealy
ROBERT A. KENEALY
S.D.B.
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